



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,199	11/16/1999	TAKANARI YAMAGUCHI	2185-0380P	3990

7590

12/30/2004

BIRCH STEWART KOLASCH & BIRCH LLP
P O BOX 747
FALLS CHURCH, VA 220400747

EXAMINER

MULLIS, JEFFREY C

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/441,199

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 5 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit 1711

The claims contain the misspelling "KFG". As load should only be mentioned in kilograms force and as applicants' own specification in fact recites the term "KGF" at page 4 line 11, it is assumed that "KGF." is intended. Correction is required.

This Office action is in response to applicants' RCE request of 8-25-04.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not

Art Unit 1711

identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ota et al. (Translation of Japanese Patent 06-57008).

See the Office action of 9-26-03 at the paragraph bridging pages 2 and 3 et seq.

Claims 2 and 10-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the translation of Ota et al., cited above.

See the Office action of 9-26-03 at the paragraph bridging pages 3 and 4 et seq.

Claims 4 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ota et al., cited above in view of Fenton (U.S. 4,584,244).

See the Office action of 9-26-03 at page 5 line 1 et seq.

Claims 1-3, 10 and 11 are rejected under 35 U.S.C. § 102(e) as being anticipated by Itoh et al. (U.S. 6,610,786).

Itoh et al. disclose a process in which a mixture of polyolefin and rubber is melt kneaded in a first extruder into a

Art Unit 1711

second extruder. Note Example 1 at column 16 line 48 - column 17 line 8. Note that the second extruder contains crystalline propylene at column 17 lines 9-19. Note that the kneaded material from the first extruder is supplied to the second extruder is supplied in the molten state at column 11 lines 2-4.

The rubber component may have a melt flow rate of 5 grams for 10 minutes under a load of 2.16 kg at 230°C at column 5 lines 6-10.

As the rubber of Itoh et al. is molten at temperatures even well below 230°C, the limitations of claims 2 and 10-11 are met.

Claims 5 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants' arguments filed 8-25-04 have been fully considered but they are not deemed to be persuasive.

Applicants argue that the Examiner is excessively emphasizing the sentence "Melt kneads component C) by the side feeder" and fails to take in consideration the other teachings of Ota '008. Firstly, the Examiner agrees the reference needs to be viewed as a whole. No teaching or suggestion should be used except in the context of the entire reference. There does not appear to be any significant disagreement between the Examiner and applicants with regard to this issue and the Examiner has no

disagreement with applicants regarding their view of the holding of In re American Academy of Science Tech Center, 70 USPQ 2d 1827 (Fed. Cir. 2004). It appears to the Examiner that the issue in the present case is whether or not the phrase "melt kneads component C) by the side feeder" is in clearly in contradiction to any other part of the Ota '008 document at least as far as the Examiner's interpretation of this phrase goes. Applicants argue that if the phrase at issue is interpreted to mean that melt kneading takes place in the side feeder, then the phrase "so that a resin composition is manufactured by only one cycle of melt kneading" is meaningless. However a "cycle" given its ordinary meaning may indicate a number of steps. Therefore the repetition of those number of steps would be needed before the cycle was repeated. The mere fact that kneading takes place in the side feeder and also in another extruder is not contradictory to the Examiner's interpretation of the phrase at issue. With regard to the disclosure at lines 1-4 from the bottom of page 14, it appears that this disclosure does not pertain to the embodiment referred to by the Examiner. Note that line 3 et seq. of page 14 recites that the "feed method is preferably the method that blends the components (A) and (B) and charges it by a main hopper or a method that feeds those components separately". Therefore lines 4-7 on page 14 describe two different embodiments, one of

which reads on the process of the instant claims and one of which does not. Applicants argue that Ota mentions the temperature of the barrel of the extruder but does not mention the temperature of the side feeder. Applicants appear to be correct regarding this. However the mere fact that the temperature of the side feeder is not mentioned is not clearly contradictory to the presence of melt kneading in the side feeder. This is so because the temperature of melting can be easily determined by those skilled in the art and there may be other reasons as to why the melting at the temperature of the side feeder is not mentioned such as the fact that polyphenyl ether has a very high meltingtemperature and it is the temperature of the main barrel which would govern the composition of any components, not that of the side feeder. In short there is nothing clearly contradictory in the document Ota as a whole indicating that melt kneading would not take place in the side feeder in any of Ota's embodiments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (571) 272-1075. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be

Serial No. 09/441,199

-7-

Art Unit 1711

reached on (571) 272-1078. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

J. Mullis:cdc

December 29, 2004

JEFFREY C. MULLIS
PRIMARY EXAMINER
GROUP 1200-12/1

